

26 APR 2006

#5



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

RICHARD S. ROBERTS  
ROBERT & ROBERTS, LLP  
P.O. BOX 484  
Princeton, New Jersey 08542-0484

|                               |   |                |
|-------------------------------|---|----------------|
| In re Application of          | : | DECISION ON    |
| Balyberdin et al              | : |                |
| PCT No.: PCT/EP03/05202       | : |                |
| Application No.: 10/517,121   | : |                |
| Int. Filing Date: 17 May 2003 | : | PETITION UNDER |
| Priority Date: 4 June 2002    | : |                |
| Attorney's Docket No.: RF-33  | : |                |
| For: METHOD AND DEVICE FOR    | : |                |
| PRODUCING ... RUBBER WASTES   | : | 37 CFR 1.47(b) |

This decision is in response to applicants' "PETITION UNDER 37 C.F.R. 1.47 AND REQUEST FOR ONE MONTH EXTENSION OF TIME" submitted on 17 October 2005 that seeks the acceptance of the application without the signature of the inventors Vladimir Balyberdin and Roudolf Gorelik. Petitioner has paid the requisite \$200 petition fee.

#### BACKGROUND

On 17 May 2003, applicant filed international application PCT/EP03/05202, which claimed priority of an earlier application filed 04 June 2002.

On 02 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 13 July 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating, *inter alia*, that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. It indicated that the current oath or declaration does not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. The notification set two months from the date of this notice or 32 months from the priority date for the application, whichever is later to respond. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) and to respond to the Notice, petitioner filed on 17 October 2005, the following:

- 1) a petition under 37 CFR 1.47(b);
- 2) a Declaration for U.S. Patent Application executed by Mr. Siegfried Kohli;
- 3) the required petition fee.

### **DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied items (1), (3), and (6) but not items (2), (4) and (5); thus not completing the requirements under 37 CFR 1.47(b).

Petitioner has satisfied item (1) because the petition fee has been provided.

Regarding requirement (2), although petitioner has concluded that the inventors refuse to sign the declaration, the petition does not include sufficient proof to establish this conclusion. The standards for proof are set forth in MPEP § 409.03(d), which provides:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted...

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

Mr. Roberts argues that Vladimir Balyberdin and Roudolf Gorelik either refused to join in the application for patent, or cannot be found or reached after diligent effort, and they have not signed the required Declaration for the patent application. Although, Mr. Roberts states that Dr. Siegfried transmitted to them the application papers, they have not responded back to him.

However, Mr. Roberts is not the person who performed the actions listed in the petition and does not have first hand knowledge of those facts as required by MPEP Section 409.03(d). He will need to submit statements, with specific facts on the actions referred to in the petition by the person, Dr. Siegfried Kohli, who has first-hand knowledge of such facts.

Furthermore, although documentary evidence to support this assertion has been provided such as the letter, the letter is in a foreign language and no English translation has been provided. Therefore, it is unclear what is said in these documents and translations of the document will need to be provided.

Also, no English translated copy of the registered returned envelope, a certified mail return receipt, and etc., as required by MPEP Section 409.03 to support his allegation about the correspondence being sent to the non-signing inventors have been provided. Therefore, it is unclear if they actually received the documents. Moreover, because Mr. Roberts alleges that they cannot be found after diligent effort, then appears that they may not be living in their last known residence. If they don't, then petitioner is under an obligation to try to find or reach them by searching them in the internet and phone-directory. Where there is an inability to find or reach a joint inventor "after diligent effort," petitioner may file a statement of facts that fully describes the exact facts which are relied on to establish that a diligent effort was made under 37 CFR 1.47.

Consequently, the petition does not include sufficient factual proof that Messrs. Balyberdin and Gorelik refuse to sign the required papers or cannot be reached or found after diligent effort.

Regarding item (3), petitioner has stated the last known addresses of the inventors

Regarding item (4) a declaration has been provided which is executed by Siegfried Kohli, Managing Director of the inventor's contractual assignee, for signing on behalf of the corporation for the non-signing co-inventors, Messrs. Balyberdin and Gorelik. However, it is unclear if Mr. Kohli has authority to sign on behalf of the corporation.

In general, a person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the organization is not presumed to be an officer or to have the authority to sign on behalf of the organization. However, an exception is made with respect to foreign juristic applicants. This is because in foreign countries, a person who holds the title "Manager" or "Director" is normally an officer or the equivalent thereof; therefore, those terms are generally acceptable as indicating proper persons to sign applications for foreign applicants. However, titles such as "Manager of Patents," suggesting narrowly limited duties, are not acceptable. In this instance, Mr. Kohli has the title Managing Director, which indicates that his title is limited.

Regarding item (5) petitioner has not submitted sufficient proof that applicant has sufficient proprietary interest in the application. The documents submitted are in a foreign language so it is unclear what is stated in them.

Regarding item (6) applicant has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage if the response to the missing parts of the application is not timely.

Accordingly, because items (2), (4) and (5) under 37 CFR 1.47(b) have not been met, it is not appropriate to accord the national stage application status at this time.

### CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

  
Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (571) 272-3276  
Facsimile: (571) 273-0459